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09/762,512	02/07/2001	Michael Moroney	102055-0051	1288

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EXAMINER

LIEN, TAN

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,512

Applicant(s)

MORONEY ET AL.

Examiner

Tan Lien

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTIONS

Drawings

The drawings were received on 02/07/2001. These drawings are not acceptable for the following reasons:

a) Lines in Figure 1-5 show no purpose. Some of the lines run across text which makes it very hard to read or not legible at all, and some run across the box arrow shown in Figure 2.

b) The background of the box arrows is dark and the texts are also dark. The combination makes it very hard to read.

c) Looking at all the Flow Charts, the examiner has no clue as to where the method or process starts and where it ends.

d) All the objects (ovals, box arrows, lines, and legends) do not have reference numbers so the examiner cannot follow when reading the specification. For those that do have reference numbers, it is not clear as to where the number is referencing.

e) The web-site server, the Internet database, and other entities should have some sort of polygon container to notify that they are structural entities, steps, or functions.

The informal drawings are not of sufficient quality to permit examination. Accordingly, new drawings are required in reply to this Office action.

Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit new drawings will result in **ABANDONMENT** of the application.

New corrected drawings are required in this application because of the drawings are incomprehensible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because the content looks like claim 1. Claim 1 is not a concise statement about the invention. It is broad in scope and breadth. Unless the claims 2-36 are withdrawn, the description of the abstract does not describe the invention as a whole.

Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

Claim 1 is objected to because of the following informalities:

a) On page 13, lines 13-15, it is not clear whether a step of a method or a structural element is being claimed in the method of claim 1. It seems like a structural element namely software searching a database for locating information. Claim 1 is a method so it should have steps, not a structural element.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim(s) 1-36: The disclosure of the invention in the specification does not describe how to make and use the invention in sufficient detail to enable one skilled in the art to make and use the invention. All the figures are so confusing that one skilled in the art would not be able to figure out what the process as defined in the claims does or where to start the process or what is involved in the process. The scope of the disclosure of the invention is similar to the scope of the claims. The claims have breadth that confuse the examiner what the claimed invention describes. There is no specific description of the invention in the specification. One skilled in the art would be forced to resort to undue experimentation in order to make and use the system and method specified in claims. For example in claim 1, presenting data fields to the user in response to user selection of data would not have been a straight forward process. It is not explained in sufficient details that would enable one skilled in the art to make and use the invention. Other examples are in claims 3, 24, and 34. The means plus function lacks structural elements in the specification. Moreover, in claims 19 and 24, how does an organization indicate interest in receiving sales leads? It is not explained in sufficient details that would enable one skilled in the art to make and use the invention. One skilled in the art would be forced to perform undue experimentation in order to make and use the system and method specified in the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 10, 13, 14, 15, 18, 21, 24, 31, 34: "or the like" and "and the like" render the claims indefinite. It is unclear what the metes and bounds of the claims describes, since "or the like" and "and the like" may refer to something not specifically recited. All dependent claims are also rejected for the same reasons by virtue of their dependency.

Claims 12, 33: "or similar electronic devices" renders the claims indefinite. It is unclear what the scope of the claims describes since "or similar electronic devices" may refer to something not specifically recited.

Claim 14: This claim recites the limitation "advertising attachment" in line 32. There is insufficient antecedent basis for this limitation in the claim.

Claim 19: The preamble to this claim is claiming a method but the body is listing structural elements with functions. One structural element is a database provider with a function of maintaining a database. Another structural element is organizations with a function of electronically indicating interest in receiving sales leads. Another structural element is a user with a function of transmitting a request. And yet another structural element is information software with a

function of categorizing the user request. Either amend the body so they are steps of a method or amend the preamble so the claim is claiming a system (change a method with a system). All dependent claims are rejected by virtue of their dependencies. In order to prosecute the examiner will presume the independent claim 19 is claiming a system.

"or the like" on page 15, line 29 renders the scope of the claim indefinite. So the examiner will presume that it is not even there.

Claims 22, 36: "or other electronic means" render the claims indefinite. It is unclear what the metes and bounds of the claims describes, since "or other electronic means" may refer to something not specifically recited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim(s) 1-2, 3-5, 7-8, 12-19, 21, 23-27, 29, 33-34 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan (US Patent 5,761,662) in view of Desai (US Patent 5,493,105).

Claim(s) 1, 12, 19, 24, 33: Dasan discloses a method of providing a user with information using the Internet, whereby the method includes:

a user accessing an organization's web-site, via a user terminal (per claim 12, the user terminal is a computer and the computer is capable of running an HTTP browser), and activating an icon located on the organization's web-site (Fig. 2 and col. 3, lines 55-58; wherein the client {ref. 100} is the user terminal and the user is using the client browser to access an organization's web-site. The user has to activate an "icon" in order to access the CGI running on the organization's web-site);

activating the icon resulting in the user being placed in communication with a database server (col. 2, lines 14-18);

presenting data fields to the user via the database server and allowing the user to select data fields of their choice, the user selections being communicated to the database server (col. 2, lines 5-18; wherein the server present data fields listing options to the client and the client provides an identification of the user-defined profile. The server engages a first application program and examines a database of information and automatically retrieves a subset of the information from the database based on the user-defined profile that the user selects to be topic of the user's interest);

locating information with a database searching software, in a database associated with the database server, based on the user selected data fields communicated to the database server (col. 2, lines 9-18; wherein the CGI software searches the database to locate for information of interest according to the selected topics in the user-defined profile); and

transmitting the located information to the user (col. 2, lines 16-17; wherein the server retrieves information of interest and transmit it to the user).

Dasan fails to disclose the located information is transmitted to the user in the form of an electronic business card. Desai, however, discloses electronic business card (abstract of Desai) and inherently its format. It would have been obvious to one of ordinary skill in the art to modify Dasan's information of interest with Desai's business card information in the electronic business card format. The reason why Dasan would want to do so is because the electronic business card provides a compact and portable way of getting information from computer readable storage media.

Claim(s) 2, 25: Dasan and Desai disclose a method as claimed in claims 1, 24 wherein,

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all communications to and from the user occur using the Internet (col. 1, lines 29-30 and Fig. 2; wherein ref. 250 of Fig. 2 shows an HTTP communications. HTTP runs on the Internet).

Claim(s) 3, 26: Dasan and Desai disclose a method as claimed in claims 1, 24 wherein, the user is provided with means to transmit user selected data fields relating to user personal information to the organization (col. 2, lines 5-8; wherein the client provides an identification of the user-defined profile after the client is presented with a list of options via HTTP as a means to transmit).

Claim(s) 4: Dasan and Desai disclose a method as claimed in claim 1 wherein, the database contains more readily accessible data relating to the organization than is presented to a user on the organization's web-site (col. 6, lines 20-50; wherein the database presents the newspaper's front page to begin with on the organization's web-site. As the user enters the appropriate information such as the user's identity submit it to the server, the server accesses the database for more readily accessible data and returns the topics of interest to the client {col. 6, lines 41-50}).

Claim(s) 5, 27: Dasan and Desai disclose a method as claimed in claim 1, 24 wherein, the information transmitted to the user is topics of interest. Dasan fails to disclose the information about at least one electronic business card of an owner,

employee, consultant or other person associated with the organization. Desai, however, discloses the displaying of information of at least two full business card entries at a time, and the display may contain information such as owner's name (col. 10, lines 46-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dasan's transmitted information of topics of interest with Desai's electronic business card information containing owner's name. The reason why Dasan would want to modify it is because Dasan wants to determine who the owner of the organization is by accessing the owner's name and to whom the electronic business card belongs (col. 10, lines 46-62).

Claim(s) 7, 29: Dasan and Desai disclose the method as claimed in claim 1 and 24,

but fails to disclose the information on the database pertaining to the organization's personnel contact information. Desai, however, discloses information kept in an organized database format, and the data on the database pertains to contacts on the electronic business card (col. 1, lines 30-35 of Desai). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Dasan's method of storing information in a database with Desai's teaching of a database pertaining to contact information. Not only does Desai's database contains contact information but also organization's information too for the database is designed to contain electronic business card information. The reason why Dasan would want to use Desai's database is because Desai's

database can also be utilized with a computer-based system to provide more complex database functions with the data (col. 1, lines 54-56 of Desai).

Claim(s) 8: Dasan and Desai disclose the method as claimed in claim 1 wherein, the database stores information relating to users who have activated the icon on the organization's web-site (abstract of Dasan; wherein if the first application program, if activated, can store a file containing the user-defined profile, then it can store information relating to users who have activated the icon on the organization's web-site).

Claim(s) 13: Dasan and Desai disclose the method as claimed in claim 1 wherein, a new organization may be electronically stored in the database (col. 2, lines 29-45; wherein the stored information in the database is up-to-date newspaper information gather by the organization that set up this web-site) by the new organization completing and electronically transmitting a registration form to a database provider (col. 7, lines 22-41; wherein the fill-in HTML form is registered via CGI. Therefore, if Dasan teaches a method of storing up-to-date data in the database and the data collected is from an HTML form, then storing organizational data in a database collected by the registration form is nothing novel nor non-obvious).

Claim(s) 14, 23: Dasan and Desai disclose the method as claimed in claim 1 wherein,

the information transmitted to the user are paid for in a separate subscription cost (Fig. 9; When the user add items to one's profile, the user is requesting form newspaper information from different sources and those sources are paid for in some way to gather or maintain the information in a server).

Claim(s) 17: Dasan and Desai disclose the method as claimed in claim 1 wherein, the information on the database is linked to more than one web-site (The purpose of a network database is to serve applications with information. In Dasan's case the network database contains interested topics of news articles based on the preference of the user-defined profile, and it is serving the web-site with information gathered by the newspaper generator in Fig. 4 of Dasan. If it is capable of serving the a CGI application on the server {Fig. 4, ref. 150} to produce an HTML page on the web-site, then it is capable of serving other web applications in a different department or company as well).

Claim(s) 15, 18, 21 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan and Desai as applied to claim(s) 1, 16, 19 above, and further in view of Taylor (US Patent 5,459,863).

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Claim(s) 15, 21: Dasan and Desai discloses the method as claimed in claims 1, 19 wherein the information stored is the user-defined profile as a flat-file and newspaper articles are stored in the database,

but fail to disclose personal particulars of the user including one's name, e-mail address, or location is stored in the database. Taylor, however, discloses storing administrative and non-administrative information such as user's name, network address, user's computer, telephone numbers, and user's relationship to other users in the organization in the network database (col. 4, lines 18-26 of Taylor). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dasan's user-defined profile with Taylor's information of user's name and relationship to other users in the organization, and Dasan's flat-file container of the user-defined profile with Taylor's container of user's name and relationship to other users in the organization as a network database. The reason why Dasan would want to modify the method is because the modification would allow the sharing of information among the divisions and departments of the company (col. 4, lines 15-17).

Claim(s) 16: Dasan, Desai, and Taylor disclose the method as claimed in claim 15 wherein,

the particulars of the user or group of users are transmitted electronically to the organization, or any of the other organizations in the database (The particulars of the user stored in a network database are discussed in Claim 15, and the

transmission of information to and from an organization is taught in Fig. 2 of
Dasan).

Claim(s) 18: Dasan, Desai, and Taylor disclose the method as claimed in claim 16
wherein,

the particulars of a user transmitted to the organization is presented to the
organization in the form of an electronic business card (Dasan taught
transmission of information to organization in Fig. 2 in Claim 1, Desai taught
electronic business card format in Claim 1, Taylor taught particulars of the user
stored in a network database in Claim 15).

Claim(s) 9-11, 20, 22, 30-32 is/are rejected under 35 U.S.C. 103(a) as being
unpatentable over Dasan and Desai as applied to claim(s) 1, 19, 24 above, and further
in view of Yoshida (US PGPub 2001/0014909 A1).

Claim(s) 9, 11, 20, 22, 30, 32, 35-36: Dasan and Desai disclose the method as claimed
in claims 1, 19, 24, 34,

but fail to disclose information about advertising may be attached to the
information presented to the user. Yoshida, however, discloses sending an email
attachment containing the advertisement to the email recipient (paragraph
[0005]; wherein the user is the email recipient and the information transmitted to

the user is via email). It would have been obvious to one of ordinary skill at the time of the invention to combine Dasan and Desai's method of transmitting information in the form of an electronic business card format with Yoshida's transmitting an email attachment containing advertisement. The reason why Dasan and Desai would want to do that is because advertisement over the Internet in the form of email attachment is efficient and it requires no cost of printed materials.

Claim(s) 10, 31: Dasan and Desai disclose the method as claimed in claims 1, 24 with selectable data field options,

but fail to disclose the selectable data fields options to include at least one option directed to departments, products, goods, services, personnel, or geographical location. Yoshida, however, disclose the sending of advertisement as attachment in the email (paragraph [0007] of Yoshida). The advertisement always contains either products of goods or services. So if Dasan teaches selectable data fields and Yoshida teaches goods or services through the advertisement, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to come up with a selectable data fields of products of goods or services. The reason why Dasan would want to combine the teachings is because the combination would give Dasan a list of defined selectable data fields to focus on, thus making the request more efficient in terms of retrieving topics of interests (col. 2, lines 5-20 of Dasan).

Claim(s) 6, 28 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan and Desai as applied to claim(s) 5, 24 above, and further in view of Kukkal (US Patent 5,774,117).

Claim(s) 6, 28: Dasan and Desai disclose a method as claimed in claim 5 above, but fail to disclose the electronic business card compatible with standard computerized address books and may be copied to standard computerized address book, Personal Digital Assistants (PDAs), or mobile phones. Kukkal, however, discloses electronic business card (FIGURE 5, ref. 38h of Kukkal; wherein the bizcard is the electronic business card) compatible with standard computerized address book and may be copied to standard computerized address book (FIGURE 5, ref. 75 and col. 5, lines 40-45 of Kukkal; wherein the "saved" bizcard in the computerized address book must have been copied to the address book in order for it to be saved). It would have been obvious to one of ordinary skill at the time of the invention to combine Dasan and Desai's method with Kukkal's teaching of storing electronic business card in a computerized address book. The reason why Dasan and Desai would want to combine is because it would make the process of retrieving the electronic business card information easier. Information stored in the address book is structured and indexed so that any program can easily access it efficiently.

Conclusion

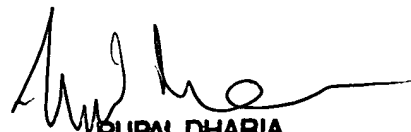
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tan Lien whose telephone number is (703) 305-6018. The examiner can normally be reached on Monday-Thursday from 8:30am to 6pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for this Group is (703) 305-3718.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [tan.lien@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER